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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,621	07/13/2001	Yukio Maruyama	089367-0114	2132
22428	7590	05/03/2006	EXAMINER	
FOLEY AND LARDNER LLP			BEKERMANN, MICHAEL	
SUITE 500			ART UNIT	
3000 K STREET NW			PAPER NUMBER	
WASHINGTON, DC 20007			3622	

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/903,621

Applicant(s)

MARUYAMA, YUKIO

Examiner

Michael Bekerman

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/13/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/13/01 & 6/24/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 7/13/2001 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because no English abstract or translation was submitted for the documents listed. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. **Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**Regarding claims 1, 5, 10, 12, and 14, these claims recite the limitation "and/or". This should read "and" or "or", but not both.**

**Regarding claim 4**, this claim recites the limitation “memory stores...movement of an image of the item”. It is unclear how memory can store movement. This is taken to read on storing data regarding a video or animated (moving) advertisement.

**Regarding claim 5**, this claim recites the limitation “voice data representing back music”. The correlation between music and voice data is unclear.

**Regarding claims 17 and 18**, these claims appear to be program claims, yet they claim structure/hardware. For example, claim 17 is a program comprising a timer and a transmission unit. For further example, claim 18 is a program comprising a memory, a display, and a controller. This is unclear.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**2. Claims 17 and 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

**Regarding claims 17 and 18**, these claims appear to be programming (or merely data) per se, which is not statutory. If the preamble set forth such computer executable instructions on a computer readable medium, then the claim would appear to be statutory. Please reference MPEP 2106 (IV) (B) (1) (a) for the basis of this rejection.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1-4, 6, 9-11, 13-15, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Heckel (U.S. Patent No. 6,036,601).** Heckel teaches a system and method of inserting advertisements into a virtual world that includes all of the limitations recited in the above claims.

**Regarding claims 1-3, 9, 10, 13-15 and 18,** Heckel teaches a server that sends an instruction to a client to show an advertisement (Column 3, Lines 37-43), and a client that displays a 3-diminsional virtual space and shows 3-dimensional advertisements (Column 4, Lines 59-67 and Column 5, Lines 1-5). As the user avatar moves within the virtual world, the advertisements appear to move. Heckel also teaches a client as displaying an avatar controlled by the user (Column 2, Lines 46-53), and a predetermined position (plug-in) where the advertisement is to be shown (Column 3, Lines 52-57).

**Regarding claim 4, 11,** Heckel teaches a memory storing an advertisement (inherently containing information on the item to be advertised) and movement of the advertisement (video clip advertisements have movement embedded in them) (Column 5, Lines 3-5). As the user avatar moves within the virtual world, the advertisements appear to move.

**Regarding claim 6**, Heckel teaches a memory storing outline IDs (plug-ins) (inherently sent to the client when the client plays the game), and displaying an advertisement in accordance with the outline data (Column 5, Lines 65-67 and Column 6, Lines 1-34).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**4. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heckel (U.S. Patent No. 6,036,601) in view of Kusumoto (U.S. Patent No. 6,954,728).**

**Regarding claims 5 and 12**, Heckel doesn't specify audio in the game advertisements. Kusumoto teaches advertisements in a virtual world game that contain audio elements (Column 6, Lines 50-55). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include audio in the advertisements of Heckel. This would draw more of the user's attention towards to advertisement.

5. **Claims 7, 8, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heckel (U.S. Patent No. 6,036,601) in view of Hunter (U.S. Pub No. 2002/0156858).**

Heckel teaches a game that implements a virtual world (a fake representation of real surroundings). Heckel doesn't specify the timing of advertisements. Hunter teaches a real world advertisement display that sells time slots to advertisers (inherently measuring an amount of time between advertisements and displaying appropriate ads at the necessary times) (Paragraph 0029). It would have been obvious to one having ordinary skill in the art at the time the invention was made to implement the real world advertisement display timing mechanism of Hunter in the virtual world advertisement display of Heckel. This would allow more advertising revenue to be gathered by the game server.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art with respect to advertising in virtual worlds:

U.S. Patent No. 6,539,544 to Ebisawa

U.S. Patent No. 6,085,256 to Kitano

U.S. Patent No. 6,616,533 to Rashkovskiy

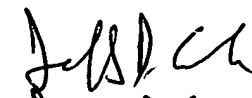
U.S. Pub No. 2001/0034665 to Ferreira

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MB

  
Jeffrey D. Carlson  
Primary Examiner